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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Katherine Woo

Title: INTEGRATING THIRD PARTY SHOPPING CART APPLICATIONS WITH AN ONLINE PAYMENT SERVICE

Docket No.: 2043.011US1
Filed: March 1, 2004
Examiner: Mark A Fadok

Serial No.: 10/791,156
Due Date: June 14, 2007
Group Art Unit: 3625

MS Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
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(GENERAL)



APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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PATENT

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The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on May 14, 2007 and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on April 9, 2007, from the Final Rejection of claims 1-24 of the above-identified application, as set forth in the Final Office Action mailed on January 8, 2007.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellant respectfully request reconsideration and reversal of the Examiner's rejections of pending claims.

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, EBAY, INC., as evidenced by the assignment recorded October 26, 2004 at Reel 015937, Frame 0519.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The present application was filed on March 1, 2004 with claims 1-24. A non-final Office Action was mailed June 13, 2006. A Final Office Action (hereinafter “the Final Office Action”) was mailed January 8, 2007. Claims 1-24 stand twice rejected, remain pending, and are the subject of the present Appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action mailed January 8, 2007.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Some aspects of the present inventive subject matter include, but are not limited to, methods and systems for integrating third party shopping cart applications with an online payment service (e.g., see FIG. 2, paragraphs [0027] - [0030], FIG. 1, paragraphs [0018] - [0025]), which are claimed in independent claims 1, 10, 18, and 22.

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the appended claims and their legal equivalents for a complete statement of the invention.

INDEPENDENT CLAIM 1

Claim 1 recites a computer-implemented method comprising:
receiving (202 of FIG. 2), from a shopping cart application (112 of FIG. 1), detailed information concerning one or more items placed by a user in a virtual shopping cart hosted by a merchant web site, the shopping cart application being external to an online payment service (110 of FIG. 1), the detailed information being sent by the shopping cart application in response to a user request to proceed with a payment for the one or more items (e.g., see paragraph [0027]); and

upon receiving the detailed information from the shopping cart application, communicating (206 of FIG. 2) to the user via a communications network (106 of FIG. 1) one or more user interfaces that facilitate processing of the payment for the one or more items, the one or more user interfaces allowing the user to view content of the virtual shopping cart (e.g., see paragraph [0029]).

INDEPENDENT CLAIM 10

Claim 10 recites apparatus comprising:
a shopping cart interface (114 of FIG. 1) to receive, from a shopping cart application (112 of FIG. 1), detailed information concerning one or more items placed by a user in a virtual shopping cart hosted by a merchant web site, the shopping cart application being external to an

online payment service (110 of FIG. 1), the detailed information being sent by the shopping cart application in response to a user request to proceed with a payment for the one or more items (e.g., see paragraph [0023]); and

a payment processor (116 of FIG. 1) to communicate, upon receiving the detailed information from the shopping cart application, to the user via a communications network (106 of FIG. 1) one or more user interfaces that facilitate processing of the payment for the one or more items, the one or more user interfaces allowing the user to view content of the virtual shopping cart (e.g., see paragraph [0024]).

INDEPENDENT CLAIM 18

Claim 18 recites a system comprising:

a merchant web site to implement a shopping cart application (112 of FIG. 1) that allows a user to place one or more items offered by the merchant web site in a virtual shopping cart hosted by the merchant web site (e.g., see paragraph [0020]);

a client (102 of FIG. 1), coupled to the merchant web site via a communications network (106 of FIG. 1), to present user interface information that facilitates processing of a user payment for the one or more items in the virtual shopping cart (e.g., see [0019], [0021]); and

an online payment service (110 of FIG. 1), coupled to the merchant web site and the client via the communications network, to receive detailed information concerning the one or more items in the virtual shopping cart from the shopping cart application, and to communicate to the user via the communications network one or more user interfaces (FIGS. 4-8) that facilitate processing of the payment for the one or more items, the shopping cart application being external to the online payment service, the one or more user interfaces allowing the user to view content of the virtual shopping cart (e.g., see paragraph [0021] – [0024]).

INDEPENDENT CLAIM 22

Claim 22 recites a computer readable medium containing instructions. When executed on a processor, the instructions cause a processor to perform a method comprising:

receiving (202 of FIG. 2), in an online payment service (110 of FIG. 1) external to a merchant web site, detailed information concerning one or more items placed by a user in a

virtual shopping cart hosted by the merchant web site, the detailed information being sent in response to a user request to proceed with a payment for the one or more items (e.g., see paragraph [0027]); and

upon the receiving of the detailed information, communicating (206 of FIG. 2) to the user via a communications network (106 of FIG. 1) one or more user interfaces that facilitate processing of the payment for the one or more items, the one or more user interfaces allowing the user to view content of the virtual shopping cart (e.g., see paragraph [0029]).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

§102 Rejection of the Claims

Claims 1-24 were rejected under 35 U.S.C. § 102(b) as anticipated by Sacks (U.S. Publication No. 2002/0016765 A1).

Because the cited reference fails to disclose each and every element of the rejected claims, the rejection of these claims fails to establish a *prima facie* case of anticipation under 35 U.S.C. § 102(b). Appellant respectfully requests reversal of the rejection of these claims.

7. ARGUMENT

Rejection Under 35 U.S.C. §102(b)

Claims 1-24 were rejected under 35 U.S.C. § 102(b) as anticipated by Sacks (U.S. Publication No. 2002/0016765 A1, hereinafter “Sacks”).

A) The Applicable Law under 35 U.S.C. §102(b)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P § 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter¹. The identical invention must be shown in as complete detail as is contained in the claim².

B) Claims 1-24 were rejected under 35 U.S.C. §102(b) as anticipated by Sacks

Because the cited Sacks does not show all elements of the rejected claims 1-24, Appellant asserts that the rejection of claims 1-24 fails to establish a *prima facie* case of anticipation under 35 U.S.C. §102(b).

Discussion of Independent Claim 1:

Independent claim 1 recites (with emphasis added):

1. A computer-implemented method comprising:
receiving, from a shopping cart application, detailed information concerning one or more items placed by a user in a **virtual shopping cart hosted by a merchant web site, the shopping cart application being external to an online payment service**, the detailed information being sent by the shopping cart application in response to a user request to proceed with a payment for the one or more items; and

upon receiving the detailed information from the shopping cart application, communicating to the user via a communications network one or more user interfaces that facilitate processing of the payment for the one or more items, the one or more user interfaces allowing the user to view content of the virtual shopping cart. (with emphasis added)

¹ *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Sacks fails to disclose the element “**the shopping cart application being external to an online payment service**” as recited in claim 1.

Appellant submits that, in contrast to claim 1, Sacks shows a system where the shopping cart application is internal to a payment processor. Referring to para 0028, 0030, 0034 and 0036 of Sacks, it can be seen clearly that the payment processor 106 includes the database 210, and the database 210 in turn stores buyer shopping carts, accordingly the payment processor 106 includes buyer shopping carts, which means that the shopping carts are internal to the payment processor 106.

“In another embodiment, **payment processor 106 may provide a third-party shopping cart to track the buyer's purchases**. Thus, in this embodiment, when a buyer's connection is redirected, the buyer may be presented with a shopping cart managed by the payment processor.” (para 0028 of Sacks)

“FIG. 2 is a block diagram of a third-party payment processor according to one embodiment of the invention. In this embodiment, **payment processor 200 comprises** communication interface 202, seller interface 204, buyer interface 206, registration module 208, **database 210** and payment processing module 212.” (para 0030 of Sacks)

“**Database 210 stores** various user information concerning buyers and sellers, such as account information, **buyer shopping carts**, HTML code for sellers, etc.” (para 0034 of Sacks)

Accordingly, Sacks fails to disclose the element “the shopping cart application being external to an online payment service” as recited in claim 1.

The element “the shopping cart application being external to an online payment service” as recited in claim 1 is not inherent to Sacks as the Final Office Action seems to suggest. The Final Office Action of 1/8/2007 restated the rejection argument of the Office Action of 6/3/2005, and disagreed with Appellant’s explanation, provided on 9/8/2005, that Sacks does not disclose the element “the shopping cart application being external to an online payment service” as recited in claim 1. Regarding this element of claim 1, the Final Office Action³ misconstrues para 0016-0023 of Sacks and asserts, “the third party payment processor is external to the payment processor.” Appellant disagrees. Because para 0016-0023 of Sacks shows that the third-party payment processor is the payment processor per se, the third party payment processor of Sacks

³ in page 4.

cannot be external to the payment processor. Referring to para 0016-0023 of Sacks (with emphasis added):

The third-party payment processor ("payment processor") receives a connection from the buyer and processes the buyer's payment using information provided by the user and/or details of the present transaction received with the buyer's connection. (emphasis added)

Sacks also fails to disclose the element "**a virtual shopping cart hosted by a merchant web site**" as recited in claim 1.

Although the Advisory Action disagrees with Appellant's argument that Sacks does not disclose "**a virtual shopping cart hosted by a merchant web site**" as recited in claim 1, it fails to point out which part of Sacks discloses this element of claim 1. It asserts "... in order for information to be collected at the merchant and later transferred to the payment processor, an application must be present on the merchant server to perform the processing." The Advisory Action appears to assume that it is inherent that in Sacks, the shopping cart must be present on the merchant server. Appellant disagrees. Because para 0028, lines 12-13 of Sacks states "the buyer's shopping cart is maintained by the third party", it is clear that Sacks does not disclose "**a virtual shopping cart hosted by a merchant web site**" as recited in claim 1.

Therefore, Appellant respectfully submits that because Sacks fails to disclose each and every element of claim 1, the rejection of claim 1 as anticipated by Sacks fails to establish a *prima facie* showing of anticipation and is improper. Accordingly, Appellant respectfully requests the rejection of claim 1 under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

Discussion of Independent Claims 10 and 18:

Independent claims 10 and 18 each recite "**the shopping cart application being external to an online payment service**" and "**a virtual shopping cart hosted by a merchant web site.**" For at least the same reasons discussed with respect to claim 1, Appellant respectfully submits that Sacks does not disclose these elements of claims 10 and 18 of the present application. Thus, the rejection of claims 10 and 18 as anticipated by Sacks is improper as failing to establish a *prima facie* showing of anticipation. Accordingly, Appellant respectfully requests reconsideration and reversal of the rejection of claims 10 and 18 under 35 U.S.C. § 102(b).

Discussion of Independent Claim 22:

Independent claim 22 recites, “**a virtual shopping cart hosted by a merchant web site**” which, as discussed above, is not disclosed in Sacks. Because Sacks does not disclose each and every element of claim 22 of the present application, the rejection of claim 22 as anticipated by Sacks is improper as failing to make a *prima facie* showing of anticipation. Accordingly, Appellant respectfully requests the rejection of claim 22 under 35 U.S.C. § 102(b) is reconsidered and withdrawn.

Discussion of Dependent Claims 2-9, 11-17, 19-21, and 23-24:

A dependent claim is deemed to include all the elements of the independent claim from which it depends. Claims 2-9, 11-17, 19-21, and 23-24 each depend, directly or indirectly, on one of claims 1, 10, 18 and 22 and add additional elements as well. For at least the reasons discussed above for the independent claims 1, 10, 18, and 22, Appellant respectfully submits that because Sacks does not disclose each and every element of these dependent claims, the rejection of these dependent claims as anticipated by Sacks is improper as failing to make a *prima facie* showing of anticipation. Accordingly, Appellant respectfully requests the rejection of these dependent claims under 35 U.S.C. §102(b) be reconsidered and withdrawn.

8. SUMMARY

For the reasons argued above and more, the examiner has failed to make a *prima facie* showing that claims 1-24 are anticipated by Sacks (U.S. Publication No. 2002/0016765 A1) under § 102(b). Thus, claims 1-24 are patentable over the cited art.

Reconsideration and allowance of pending claims 1-24 are respectfully requested.

Respectfully submitted,

KATHERINE WOO

By her Representatives,

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Date 06/14/2007

By



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Name Dawn R. Shaw

/Dawn R. Shaw/
Signature

CLAIMS APPENDIX

1. A computer-implemented method comprising:

receiving, from a shopping cart application, detailed information concerning one or more items placed by a user in a virtual shopping cart hosted by a merchant web site, the shopping cart application being external to an online payment service, the detailed information being sent by the shopping cart application in response to a user request to proceed with a payment for the one or more items; and

upon receiving the detailed information from the shopping cart application, communicating to the user via a communications network one or more user interfaces that facilitate processing of the payment for the one or more items, the one or more user interfaces allowing the user to view content of the virtual shopping cart.

2. The computer-implemented method of claim 1 wherein the detailed information is selected, for each of the one or more items, from the group consisting of an item name, an item number, an item price and an item quantity.

3. The computer-implemented method of claim 1 wherein the user request to proceed with the payment is received when the user clicks a checkout button on the merchant web site.

4. The computer-implemented method of claim 1 wherein the one or more user interfaces comprise a login user interface to facilitate user input of personal information and a payment confirmation user interface to facilitate user input confirming the payment.

5. The computer-implemented method of claim 4 wherein the payment confirmation user interface displays the contents of the virtual shopping cart.

6. The computer-implemented method of claim 4 wherein the login user interface includes a link to the contents of the virtual shopping cart.

7. The computer-implemented method of claim 4 wherein the personal information includes user credit card information if the user is a new user of the online payment service.
8. The computer-implemented method of claim 1 further comprising:
upon processing the payment for the one or more items, presenting to the user a personal account user interface displaying information concerning the payment.
9. The computer-implemented method of claim 8 wherein the personal account user interface includes a link to the contents of the virtual shopping cart.
10. An apparatus comprising: a shopping cart interface to receive, from a shopping cart application, detailed information concerning one or more items placed by a user in a virtual shopping cart hosted by a merchant web site, the shopping cart application being external to an online payment service, the detailed information being sent by the shopping cart application in response to a user request to proceed with a payment for the one or more items; and
a payment processor to communicate, upon receiving the detailed information from the shopping cart application, to the user via a communications network one or more user interfaces that facilitate processing of the payment for the one or more items, the one or more user interfaces allowing the user to view content of the virtual shopping cart.
11. The apparatus of claim 10 wherein the detailed information is selected, for each of the one or more items, from the group consisting of an item name, an item number, an item price and an item quantity.
12. The apparatus of claim 10 wherein the user request to proceed with the payment is received when the user clicks a checkout button on the merchant web site.

13. The apparatus of claim 10 wherein the one or more user interfaces comprise a login user interface to facilitate user input of personal information and a payment confirmation user interface to facilitate user input confirming the payment.

14. The apparatus of claim 13 wherein the payment confirmation user interface displays the contents of the virtual shopping cart.

15. The apparatus of claim 13 wherein the login user interface includes a link to the contents of the virtual shopping cart.

16. The apparatus of claim 10 wherein the payment processor is further to present to the user a personal account user interface displaying information concerning the payment upon processing the payment for the one or more items.

17. The apparatus of claim 16 wherein the personal account user interface includes a link to the contents of the virtual shopping cart.

18. A system comprising:

a merchant web site to implement a shopping cart application that allows a user to place one or more items offered by the merchant web site in a virtual shopping cart hosted by the merchant web site;

a client, coupled to the merchant web site via a communications network, to present user interface information that facilitates processing of a user payment for the one or more items in the virtual shopping cart; and

an online payment service, coupled to the merchant web site and the client via the communications network, to receive detailed information concerning the one or more items in the virtual shopping cart from the shopping cart application, and to communicate to the user via the communications network one or more user interfaces that facilitate processing of the payment for the one or more items, the shopping cart application being external to the online payment service, the one or more user interfaces allowing the user to view content of the virtual

shopping cart.

19. The system of claim 18 wherein the detailed information is selected, for each of the one or more items, from the group consisting of an item name, an item number, an item price and an item quantity.

20. The system of claim 18 wherein the user request to proceed with the payment is received when the user clicks a checkout button on the merchant web site.

21. The system of claim 18 wherein the one or more user interfaces comprise a login user interface to facilitate user input of personal information and to display the contents of the virtual shopping cart, and a payment confirmation user interface to facilitate user input confirming the payment and to include a link to the contents of the virtual shopping cart.

22. A computer readable medium comprising instructions, which when executed on a processor, cause the processor to perform a method comprising:

receiving, in an online payment service external to a merchant web site, detailed information concerning one or more items placed by a user in a virtual shopping cart hosted by the merchant web site, the detailed information being sent in response to a user request to proceed with a payment for the one or more items; and

upon the receiving of the detailed information, communicating to the user via a communications network one or more user interfaces that facilitate processing of the payment for the one or more items, the one or more user interfaces allowing the user to view content of the virtual shopping cart.

23. The computer readable medium of claim 22 wherein the detailed information is selected, for each of the one or more items, from the group consisting of an item name, an item number, an item price and an item quantity.

24. The computer readable medium of claim 22 wherein the one or more user interfaces comprise a login user interface to facilitate user input of personal information and to display the contents of the virtual shopping cart, and a payment confirmation user interface to facilitate user input confirming the payment and to include a link to the contents of the virtual shopping cart.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.